

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: L. Garren Du et al.	Art Unit	: 3685
Patent No.	: 7,895,123	Examiner	: Jalatee Worjloh
Issue Date	: February 22, 2011	Conf. No.	: 3522
Serial No.	: 09/879,267		
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Title	: DIGITAL CONTENT PUBLICATION		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 734 days to 818 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees respectfully submit that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

A reply to a Notice to File Missing Parts was due on or before November 15, 2001 (the date that is three months after August 15, 2001, the date on which the Notice to File Missing Parts was mailed). Patentees filed a response to the Notice to File Missing Parts on December 4, 2001. Patentees were accorded 0 days delay for a late response. In good faith and candor, Patentees submit that the late response should have been accorded a total Applicant Delay of 19 days for delay from November 16, 2001 (the day after the date that is three months after the date on which the Notice to File Missing Parts was mailed), to December 4, 2001. See 37 C.F.R. § 1.704(b).

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: April 13, 2011.

A reply to an Office Action was due on or before July 26, 2004 (the date that is three months after April 26, 2004, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on September 22, 2004, thereby according an Applicant Delay of 58 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from July 27, 2004 (the day after the date that is three months after the date on which the Office Action was mailed), to September 22, 2004. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before March 14, 2005 (the date that is three months after December 14, 2005, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on March 16, 2005, thereby according an Applicant Delay of 2 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from March 15, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to March 16, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before January 21, 2006 (the date that is three months after October 21, 2005, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on February 10, 2006, thereby according an Applicant Delay of 20 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from January 22, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to February 10, 2006. See 37 C.F.R. § 1.704(b).

Patentees filed an Information Disclosure Statement on March 6, 2006, subsequent to a reply filed on February 10, 2006. Patentees were accorded 0 days delay for a supplemental response. In good faith and candor, Patentees submit that the late response should have been accorded a total Applicant Delay of 24 days for delay from February 11, 2006, to March 6, 2006. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before July 27, 2006 (the date that is three months after April 27, 2006, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on July 31, 2006, thereby according an Applicant Delay of 4 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from July 28, 2006 (the

day after the date that is three months after the date on which the Office Action was mailed), to July 31, 2006. See 37 C.F.R. § 1.704(b).

Patentees filed an Information Disclosure Statement on August 18, 2006, subsequent to a reply filed on July 31, 2006. Patentees were accorded a delay of 18 days for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from August 1, 2006, to August 18, 2006. See 37 C.F.R. § 1.704(c)(8).

Patentees filed an Information Disclosure Statement on October 20, 2006, subsequent to a reply filed on August 18, 2006. Patentees were accorded a delay of 63 days for a supplemental response. Patentees do not dispute the PTO's calculation for this Applicant Delay from August 19, 2006, to October 20, 2006. See 37 C.F.R. § 1.704(c)(8).

Patentees filed a Request for a Corrected Filing Receipt on January 10, 2011, subsequent to the mailing of the Notice of Allowance. The PTO mailed a Corrected Filing Receipt on January 14, 2011. Patentees were accorded 0 days delay for a supplemental response. In good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 5 days for delay from January 10, 2011, to January 14, 2011. See 37 C.F.R. § 1.704(c)(10).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 213 days (the sum of 19 days, 58 days, 2 days, 20 days, 24 days, 4 days, 18 days, 63 days, and 5 days).

"A Delay"

A first PTO action was due on or before August 12, 2002 (the date that is fourteen months after June 12, 2001, the date on which the application was filed). The PTO mailed the first non-final Office Action on April 26, 2004, thereby according a PTO Delay of 623 days. Patentees do not dispute the PTO's calculation for this "A Delay" from August 13, 2002 (the day after the date that is fourteen months after the date on which the application was filed), to April 26, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 623 days.

“B Delay”

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to “B Delay” to compensate for that Office delay. The only issue in contention is the correct length of the “B Delay” period.

The period beginning on June 13, 2004 (the day after the date that is three years after the date on which the application was filed), and ending February 22, 2011 (the date the patent was issued), is 2,446 days in length. The “PTA 36 Months” entry in the PAIR/PALM system indicates that a total of 276 days were awarded for “B Delay” for this patent. Patentees respectfully submit that the PTO’s calculation of this “B Delay” is incorrect.

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay “any time consumed by continued examination of the application.” In the present matter, Requests for Continued Examination were filed on March 16, 2005, February 10, 2006, and December 23, 2009. The Director erred in the calculation of patent term adjustment by subtracting from B Delay a period of time that was not “consumed by continued examination of the application.” The PTO mailed a Notice of Allowance on October 14, 2010, thereby closing examination of the application on that date. Thus, no continued examination took place during the 132 day period from October 14, 2010 (the mailing date of the Notice of Allowance) until February 22, 2011 (the date the patent was issued). Accordingly, 132 days of B Delay should have been included in addition to the 276 days accorded by the Director, for a total B Delay of 408 days. Patentees respectfully submit that the Office’s calculation of “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 408 days.

Overlap of “A Delay” and “B Delay”

As detailed above, 623 days of “A Delay” accumulated during the following period:

August 13, 2002, to April 26, 2004.

As detailed above, 408 days of “B Delay” accumulated during the following period:

June 13, 2004, to March 16, 2005; and

October 14, 2010, to February 22, 2011.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 734 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,031 days (i.e., the sum of 623 days of "A Delay" and 408 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 213 days; and
- 3) Total PTA should be calculated as 818 days.

The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 12587-0015001.

Respectfully submitted,

Date: April 13, 2011

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